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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,943	06/26/2003	Kouji Hattori	239612US0	3410

22850 7590 07/08/2004

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EXAMINER

CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/603,943	HATTORI ET AL.	
	Examiner	Art Unit	
	Celia Chang	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 26 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-11 are pending.

2. *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, 7, 9-11 when A is phenyl B is phenyl or naphthyl, drawn to aromatic carboxylates, classified in class 560 subclass 562.
- II. Claims 1-5, 7, 9-11 when A is phenyl B is pyridyl, drawn to pyridyl compounds, classified in class 546, subclass 280+.
- III. Claims 1-5, 7, 9-11 when A is phenyl B is thienyl, drawn to thienyl compounds, classified in class 549, subclass 64.
- IV. Claims 1-5, 7, 9-11, when A is phenyl B is piperidinyl, drawn to piperidinyl compounds classified in class 546, subclass 211.
- V. Claims 1-5, 7, 9-11 when A is pyridinyl B is phenyl or naphthyl, drawn to pyridinyl compounds, classified in class 546 subclass 339.
- VI. Claims 1-5, 7, 9-11 when A is pyridinyl B is pyridinyl, drawn to bis-pyridyl compounds, classified in class 546, subclass 267.
- VII. Claims 1-5, 7, 9-11 when A is pyridinyl B is thienyl, drawn to pyridine-thienyl compounds, classified in class 546, subclass 280.4.
- VIII. Claims 1-5, 7, 9-11, when A is pyridinyl B is piperidinyl, drawn to piperidinyl-pyridine compounds classified in class 546, subclass 193.
- IX. Claim 6, drawn to processes of making compounds, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species of product being made is also required.
Further restriction may be required.

Claim 8 is drawn to the nonstatutory "use" format which was withdrawn from consideration. Cancellation is recommended.

The inventions are distinct, each from the other because:

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Compounds of groups I-VIII are independent and distinct because unpatentability of any one group of compound would not imply unpatentability of another group of compounds. The elements, bonding arrangement and chemical properties among the difference groups differ in such an extent that a reference anticipating one group would not render the other groups obvious. The searches for each group is not coextensive of another. A tremendous burden would be imposed on the PTO were the claims not restriction. Should applicant traverse on the ground that the groups or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the groups or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. In the instant case, then there could have been no patentability of all the claims since group I compounds are anticipated by Hurnaus et al. CA 111:77643, see RN121805-07-0.

Inventions IX and I-VIII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case it is evidenced that at least six processes employing different starting material, different steps and operating conditions as (i)-(vi) of claim 6 can be used, each independent process can produce some of the compounds.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


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3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
July 1, 2004


Celia Chang
Primary Examiner
Art Unit 1625